

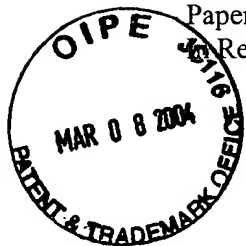
3629

Published Application No. 2001/0014865 A1

Attorney Docket No. 1762-001648

Paper Dated: March 4, 2004

Reply to #67090 v1 - Ungerboeck USI Protest to PTO



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/809,595
Applicants : **Paul D. FRANKE**
Title : **METHOD AND SYSTEM FOR CONDUCTING A
PLURALITY OF CYBER-BASED CONVENTIONS**
Filed : March 15, 2001
Group Art Unit : 3629
Examiner : Thomas A. Dixon

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RESPONSE TO PROTEST AGAINST PATENT APPLICATION

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTION

Pursuant to 37 C.F.R. § 1.99, relating to third-party submissions in published applications, Applicant, Paul D. Franke, has received a document entitled "Protest Against Patent Application with Citation of Prior Art System 'On-Sale' Submitted Under 37 CFR 1.99," filed by Protestor Ungerboeck Systems International ("USI") by and through USI's counsel, Mr. Peter S. Gilster. Both USI and Mr. Gilster have made numerous incorrect statements throughout this Protest and, in any case, the filed Protest does not meet the requirements of 37 C.F.R. § 1.99.

INCONSISTENT AND/OR INCORRECT STATEMENTS

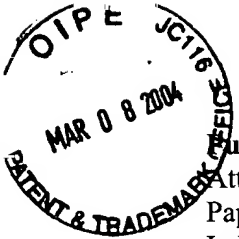
In the interest of clarity, and so as not to burden the Examiner with excessive argument, Applicant, Paul Franke and Software Management, Inc. ("SMI") respectfully note the following inconsistencies: (1) SMI has not "wrongfully and recklessly" charged USI of infringement; (2) USI did not offer to "demonstrate" the EBMS System to either the undersigned, SMI and/or Mr. Franke; (3) while Mr. Gilster did "offer" to share "an understanding of the state of the EBMS functionality", he did not offer any demonstration of a verifiable copy of the EBMS System as of 1995 and/or 1997; (4) the undersigned did request full working copies of the EBMS software, to which Mr. Gilster did not respond (see attached letter dated December 12, 2003); and (5) Applicant does not believe that the information provided to the Examiner is verifiable and bears directly on or is highly material to the issue of patentability of the claims of the pending application.

FAILURE TO COMPLY WITH 37 C.F.R. § 1.99

More importantly, the Protest submitted on behalf of USI by Mr. Gilster does not meet the requirements of Section 1.99. Specifically, Section 1.99(d) states that "[a] submission under this section shall not include any explanation of the patents or publications, or any other information." (emphasis added). Even a cursory review of the Protest serves to evidence a three-page letter to the Examiner explaining and providing information (albeit incorrect) regarding the alleged EBMS System, correspondence with the undersigned and SMI, an explanatory listing of various appendices, an explanation of the effort and expense expended by Protestor, etc. In addition, as opposed to merely submitting the patent or publication, USI and Mr. Gilster included a letter between counsel for USI and counsel for

SMI, an Opinion letter of Mr. Reed, a development chronology, a database diagram and a resume of Mr. Reed. USI has egregiously ignored the requirements of Section 1.99(d) and included considerable explanation and other information in the Protest. Accordingly, the Patent Office is required to "dispose of such explanation or information if included in a submission under this section." Applicant respectfully requests that the Patent Office and/or the Examiner handling this matter dispose of all materials, information and explanation provided in the Protest, other than the "marketing brochure" allegedly published in 1995.

Next, with respect to Section 1.99(e), "[a] submission under this section must be filed within two months from the date of publication of the application or prior to the mailing of a Notice of Allowance, whichever is earlier. Any submission under this section not filed within this period is permitted only when the patents or publications could not have been submitted to the Office earlier, and must also be accompanied by the processing fee set forth...." Mr. Gilster argues that the submission could not have been filed within two months from the date of publication of the application, since the subject patent application was not known to Protestor, until receipt of "the aforesaid letter identified in the above paragraph A." The undersigned is unsure to what paragraph A Mr. Gilster is referring, however, in the second paragraph of the Protest, USI alleges that SMI charged USI with infringement by letter dated April 28, 2003. The above-referenced patent application was published on August 16, 2001. Accordingly, the presently-submitted Protest was filed more than 2 ½ years after the publication, and more than ten months after actual notice (roughly in April of 2003) of the publication. Therefore, even a marginally reasonable argument cannot be made that this Protest complies with Section 1.99(e). Under this Section, "[a] submission by a member



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of the public to a pending published application that does not comply with the requirements of this section will not be entered." Applicant respectfully requests that the Patent Office and/or the Examiner return or discard the Protest, together with the entire submission.

SUMMARY


Applicant has decided not to engage in a debate about the unverifiable EBMS System brochure, and the immaterial nature of this submission. Of course, if the Patent Office and/or the Examiner would like to entertain SMI's comments on this brochure, such a submission will be provided pursuant to the Patent Office and/or the Examiner's request. In any case, for the above reasons, and for the failure to comply with the requirements as set forth in 37 C.F.R. § 1.99, Applicant respectfully requests that the Protest, together with the attachments and submissions included therewith, be returned and/or discarded.

Respectfully submitted,

WEBB ZIESENHEIM LOGSDON
ORKIN & HANSON, P.C.

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Dated March 4, 2004

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GROUP 3600



CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing RESPONSE TO PROTEST AGAINST PATENT APPLICATION was served by first class mail, postage prepaid, on this 4th day of March, 2004 upon the following counsel for Protestor:

Peter S. Gilster, Esq.
Greensfelder, Hemker & Gale, P.C.
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